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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/650,858	08/29/2000	Jung-wan Ko	1293.1130/MDS	9518

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EXAMINER

HUBER, PAUL W

ART UNIT PAPER NUMBER

2653

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/650,858	<b>Applicant(s)</b> KO, JUNG-WAN	
	<b>Examiner</b> Paul Huber	<b>Art Unit</b> 2653	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30, 45 and 46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24-30 is/are allowed.
- 6) ☒ Claim(s) 1-7, 10-16, 45 and 46 is/are rejected.
- 7) ☒ Claim(s) 8, 9 and 17-23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12092004</u> . | 6) <input type="checkbox"/> Other: _____  |

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Claims 1-4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of copending Application No. 09/694,787. Although the conflicting claims are not identical, they are not patentably distinct from each other because each and every limitation of the instant application can be found in the copending application '787 claims, and it would be obvious to remove the limitation from the copending application '787 claims thereby resulting in the instant application claims for the purpose of simplifying the invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 10-16, 45 and 46 are rejected under 35 U.S.C. 102(b) as being anticipated by Takahashi (USP-5,878,020).

Regarding claims 1, 2, 10 and 11, Takahashi discloses a method of recording compatibility information on a recording medium. See figures 14-16. A physical format information zone is provided having a reserved zone. The claimed reserved zone is interpreted by the examiner to be the region of the medium reserved for the part version information (fig. 16). Part version information (claimed "extended part version information" and claimed "detailed extended part version information") is recorded in the reserved zone of the physical format information zone. The particular area within the physical format information zone of the recording medium 'reserved' for various part version

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information, can record a variety of different part version information, (e.g., extended part version information or detailed extended part version information).

Regarding claims 3, 4, 12, and 13, Takahashi discloses in figure 16 that the recording of the part version information (claimed 'extended part version information) further includes recording a latest part version as claimed, i.e., version most recently recorded. The latest part version being interpreted as subsequent version, "0001b: VER. 1.0" or "others: reserved".

Regarding claims 5-7 and 14-16, Takahashi discloses in figure 16 that each of the extended part version and latest part version, i.e., bits b3 through b0, comprise recording an integer part and a first decimal place in the reserved zone as claimed. For example, "VER. 1.0", wherein the '1' is the integer part and the '0' is the first decimal place as claimed. In addition, each of the extended part version and latest part version further include recording a second decimal place immediately after the first decimal place, i.e., inherent in the "others: reserved" which allows such versions as needed.

Regarding claim 45, Takahashi discloses an optical disc having extended part version information stored thereon, for example, '0001b: VER. 1.0' in bits b3 through b0. See figure 16. The extended part version information is used to determine in a recording/reproducing apparatus whether recording/updating or reproducing can be performed on the recording medium which is made in compliance with an newly revised specification.

Regarding claim 46, Takahashi discloses a recording medium having a book type (claimed "updated specification") information stored thereon, which maintains recording/updating compatibility with a recording/reproducing apparatus as claimed. See figure 16. The recording medium further includes a part version (claimed "latest part version") which maintains reproducing compatibility with the recording/reproducing apparatus. The part version is recorded on the recording medium having an updated specification such that data is recordable/updatable or reproducible by a recording/reproducing apparatus having an existing specification as claimed.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kondo and Tanaka et al each disclose a recording medium having a physical format information zone.

Claims 8, 9, and 17-23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 24-30 are allowed.

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Applicant's arguments filed August 24, 2004 have been fully considered but they are not persuasive.

The applicant argues that the "reference does not disclose recording part version information in a reserved zone of the physical format information zone" as claimed. The examiner respectfully disagrees. As described in the rejection above, Takahashi discloses a physical format information zone which is provided having a reserved zone. The claimed reserved zone is interpreted by the examiner to be the region of the medium of Takahashi reserved for the part version information (fig. 16). Part version information (claimed "extended part version information" and claimed "detailed extended part version information") is recorded in the reserved zone of the physical format information zone. The particular area within the physical format information zone of the recording medium 'reserved' for various part version information, i.e., bit b3 through b0, can record a variety of different part version information, (e.g., extended part version information or detailed extended part version information). Accordingly, the rejection is considered proper and is maintained.

The applicant further argues that, regarding claim 3, "there is no indication that these 'others' have recording compatibility with a recording/reproducing apparatus of a given specification level. In fact, the compatibility information is not discussed whatsoever." The examiner respectfully disagrees. Claim 3 recites recording of the extended part version information comprising recording a latest part version. This is interpreted by the examiner to read upon Takahashi which discloses in figure 16 that the recording of the part version information (claimed 'extended part version information) further includes recording a latest part version as claimed, i.e., version most recently recorded. Furthermore, this latest part version has recording compatibility with a recording/reproducing apparatus of a given specification level as claimed because figure 16 shows for example that version 0.9 is for test use only which is considered a version having recording compatibility with a recording/reproducing apparatus of a given specification level as claimed. Accordingly, the rejection is considered proper and is maintained.


Regarding claims 4 and 46, the applicant argues that "compatibility is not disclosed in Takahashi". The examiner respectfully disagrees. The latest part version, e.g., version 0.9, has recording compatibility or reproducing compatibility with a recording/reproducing apparatus of a given specification level, in so much that the recording/reproducing apparatus performs recording and/or reproducing according to the latest part version, e.g., "for test use only". Accordingly, the rejection is considered proper and is maintained.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Paul Huber at telephone number 703-308-1549.



Paul Huber  
Primary Examiner  
Art Unit 2653

pwh  
January 10, 2005